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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,650	08/25/2003	Marcus Andrew Stoodley	11280.1002cip	3875

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PELOQUIN, PLLC
MARK PELOQUIN
800 FIFTH AVE
SUITE 4100
SEATTLE, WA 98104-3100

EXAMINER

AMSBURY, WAYNE P

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 03/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/648,650

Applicant(s)

STOODLEY ET AL.

Examiner

Wayne Amsbury

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/2/4.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

CLAIMS 1-39 ARE PENDING

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-39 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-40 of U.S. Patent No. 6,611,846. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ in the arrangement of elements, broadening, and further limiting well within the purview of those of ordinary skill in the art at the time of the invention.

Using claim 1 of both the application and '846 as exemplary, the claim is broadened at line 2 by involving a database as opposed to a relational database; it is narrowed somewhat by omitting potential categories at line 4 after two of, but this is a slight broadening itself, and the application includes presenting results, without which

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there is little point to the method. The application claim 1 is thus a restatement and obvious variation of the invention of the '864 claim 1.

2. (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 4, 6 are rejected under 35 U.S.C. 102(e) as being anticipated by

Barry et al (Barry), US 5,991,729, 23 November 1999.

Barry is directed to generating patient-specific medical reports that include diagnostic analysis, which corresponds to analyzing healthcare data [COL 1 lines 5-18].

As to **claim 1**:

The claim as a whole is taught essentially as claimed in Barry at COL 2 line 66 to COL 3 line 62. In more particular:

Barry uses a relational database to maintain data sets specific to a particular patient [FIG 1; COL 1 lines 10-13]. A patient identifier is used [COL 2 line 67]. It is inherent in a relational database system that data is maintained in tables, organized by criteria (column designators). [See also COL 1 line 67 to COL 2 line 3].

Barry manages data in the categories of diagnosis [COL 2 lines 32-34] and outcomes in the form of reports [COL 2 lines 49-59], treatment COL 3 lines 13-18], all of which are identified by patient.

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Archival information concerning groups common to a diagnosis at least is determined in order to display a report (which corresponds to a presentation). See, for instance, the example of Barrett's Esophagus [COL 4 lines 27-52].

As to **claim 3**, the Barrett's Esophagus example of Col 4 lines 26-52 is a diagnosis category of pathological examination results. As to **claim 4**, Barry sets forth treatment categories for this disease in the passage cited.

As to **claim 6**, Barry includes multimedia data in the database and reports [COL 4 lines 21-26].

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2, 5, 7-12 and 30-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barry et al (Barry), US 5,991,729, 23 November 1999.

As to **claim 2**, Barry teaches the use of codes such as diagnostic codes, physician codes, and the like, the latter of which is explicitly alphanumeric [COL 2 lines 43-48]. Barry does not address the use of more than one language, but it was well known in the art at the time of the invention for Physicians to use Latin terms in healthcare descriptions. **It would have been obvious** to one of ordinary skill in the art at the time of the invention to provide for Latin as well as a native language because it supports standard and precise descriptions.

As to **claim 5**, Barry does not explicitly list the scores and effects as cited, but it **would have been obvious** to one of ordinary skill in the art at the time of the invention to provide for them because they are useful components of extended treatments and of diagnostic data. Including the elements of **claims 7-9** into the system of Barry would have been obvious to one of ordinary skill in the art for similar reasons. They fall within the category of intended applications of the invention to specific data that would have been useful as support for the diagnosis reporting of Barry. Using claim 8 as exemplary, treatment regimes are tasks of patient management, the archival information relating to an example such as Barrett's is useful for training of healthcare professionals and/ or certification of those tested for diagnostic abilities, and so on. Multimedia files have been addressed above.

As to **claims 11 and 12**, it was well known in the art at the time of the invention to arrange data in a hierarchical tree for purposes of searching such a manner that lower levels are of increasing specificity. The motivation for such an arrangement is the efficiency of a directed search.

The elements of **claims 30-39** are rejected in the analysis above and these claims are rejected on that basis.

3. Claims 13-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barry et al (Barry), US 5,991,729, 23 November 1999 in view of Schneiderman, US 5,099,424, 24 March 1992.

Barry does not address the use of a linking event identifier, although clearly any data dealing with a specific patient must identify that patient, no matter what category or table contains the data. Thus Barry must have some mechanism that provides the same functionality. Barry also does not address patient management explicitly.

Schneiderman is directed to processing clinical data processing that tracks outpatient practice [COL 1 lines 9-59]. This is an improvement on prior art that used a patient identifier stored in data records [FIG 26 for example], which in turn include management and surgery records [COL 7 lines 31-39]. The events in Schneiderman include EKG and CXR records [COL 1 line 60 and after].

It would have been obvious to one of ordinary skill to use the linking mechanism of Schneiderman and his prior art in the patient specific medical reports of

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Barry because they link together data that is both specific to a patient and significant to diagnosis, treatment, and outcome.

The combination teaches the use linked records of the types set forth in both teachings, wherein a linking event identifier can be the patient ID. With this combination, the elements of the claims are rejected in the analysis above and these claims are rejected on that basis.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wayne Amsbury whose telephone number is 571-272-4015. The examiner can normally be reached on M-F 6-18:30 FIRST WEEK.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WPA


WAYNE AMSBURY
PRIMARY PATENT EXAMINER